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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,621	08/14/2001	Richard Franklin Wormsbecher	W9495-01	9407

7590

03/18/2003

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EXAMINER

THERKORN, ERNEST G

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 03/18/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,621

Applicant(s)

WORMS BECHER

Examiner

THIERKORN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 14, 2003
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above, claim(s) 10-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2, 3, 4, 5
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 7-9 are rejected under 35 U.S.C. 102(B) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over each of Ho Chang (U.S. Patent No. 4,029,583), Boos (U.S. Patent No. 6,074,555), and Hanggi (U.S. Patent No. 5,667,674). The claims are considered to read on each of Ho Chang (U.S. Patent No. 4,029,583), Boos (U.S. Patent No. 6,074,555), and Hanggi (U.S. Patent No. 5,667,674). However, if a difference exists between the claims and each of Ho Chang (U.S. Patent No. 4,029,583), Boos (U.S. Patent No. 6,074,555), and Hanggi (U.S. Patent No. 5,667,674), it would reside in optimizing the elements of each of Ho Chang (U.S. Patent No. 4,029,583), Boos (U.S. Patent No. 6,074,555), and Hanggi (U.S. Patent No. 5,667,674). It would have been obvious to optimize the elements of

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each of Ho Chang (U.S. Patent No. 4,029,583), Boos (U.S. Patent No. 6,074,555), and Hanggi (U.S. Patent No. 5,667,674) to enhance separation.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over each of Ho Chang (U.S. Patent No. 4,029,583), Boos (U.S. Patent No. 6,074,555), and Hanggi (U.S. Patent No. 5,667,674) in view of Goetz (U.S. Patent No. 5,055,194). The claim differs from each of Ho Chang (U.S. Patent No. 4,029,583), Boos (U.S. Patent No. 6,074,555), and Hanggi (U.S. Patent No. 5,667,674) in reciting a magnetically responsive substance. Goetz (U.S. Patent No. 5,055,194) (column 1, lines 13-17 and column 9, lines 13-21) discloses that use of a magnetic core allows the material to be used for a magnetically stabilized fluidized bed. It would have been obvious to use a magnetic core in each of Ho Chang (U.S. Patent No. 4,029,583), Boos (U.S. Patent No. 6,074,555), and Hanggi (U.S. Patent No. 5,667,674) because Goetz (U.S. Patent No. 5,055,194) (column 1, lines 13-17 and column 9, lines 13-21) discloses that use of a magnetic core allows the material to be used for a magnetically stabilized fluidized bed.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boos (U.S. Patent No. 6,074,555) in view of Ho Chang (U.S. Patent No. 4,029,583). At best, the claim differs from Boos (U.S. Patent No. 6,074,555) in reciting use of silica gel. Ho Chang (U.S. Patent No. 4,029,583) (column 4, lines 13-15) discloses that silica and silica gel are interchangeable supports. It would have been obvious to use silica gel in Boos (U.S. Patent No. 6,074,555) because Ho Chang (U.S. Patent No. 4,029,583) (column 4, lines 13-15) discloses that silica and silica gel are interchangeable supports.

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The remarks urge that the method of Group III is the only way to produce the solid of claim 1. However, as stated in the office action of December 10, 2002, the product could be made by agglomerating an R_{10} containing compound from solution onto the support. As such, the examiner has produced an example of an alternative method for producing the product of claim 1.

The remarks urge that the search would be the same for Groups I and III. Group III would at the very least require additional searching in Class 502, subclass 439 as well as other subclasses. The additional search and different issues of patentability would be an enormous burden on the examiner.

The remarks propose an alternative standard to the Election I requirement. The correct standard to apply is whether the species are patentably distinct. Each of an inorganic material without a binding moiety and without a linker, an inorganic material with a binding moiety, and an inorganic material without a binding moiety and with a linker is considered to be patentably distinct. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

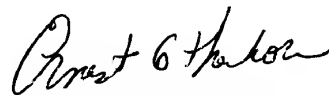
The remarks urge with regard to Election II, III, IV, and V that it would not be a serious burden on the examiner to search and examine the numerous patentably distinct species.

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However, searching and examining the numerous patentably distinct species would be an enormous burden on the examiner.

Accordingly, the restriction requirement and elections of species requirement have been reconsidered, deemed proper, and made final for the reasons of record.

Any inquiry concerning this communication should be directed to E. Therkorn at telephone number (703) 308-0362.



Ernest G. Therkorn
Primary Examiner
Art Unit 1723

EGT/12
March 13, 2003